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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,298	12/17/2001	Martin P. Madden	2815RCE	8174

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EXAMINER

BASHORE, ALAIN L

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/023,298

Applicant(s)

MADDEN, MARTIN P.

Examiner

Alain L. Bashore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2-28-03 and 5-6-03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81. No new matter may be introduced in the required drawing.

A least one block diagram that shows the computerized elements and at least one flow chart that shows the recited steps.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The whereby clause recites in claims 1 and 8 includes "maybe" which renders the entire clause indefinite because the patentable weight of the recitation is unclear.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-8 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility.

Based on applicant's specification and recited claims as now amended, a new type of financial instrument – a deposit liabilities contract – is being claimed. This is in direct conflict with the prior art reference entitled "The Bank Valuation Handbook" to Johnson (Johnson). Johnson teaches that core deposit intangibles "do not qualify as financial instruments" (see section entitled "financial statement disclosure").

6. Claims 1-8 are rejected under 35 U.S.C. 101 as non-statutory because the method claims as presented do not claim a technological basis. Without a claimed basis, the claims are interpreted as involving no more than a manipulation outside of a technological art and therefore non-statutory under 35 U.S.C. 101.

In contrast, a method claim that includes in the preamble and body of the claim structural / functional interrelationships that are solely by computer (and non-trivial) are considered to have a technological basis and thus within the technological arts [See *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) – used only for content and reasoning since not precedential].

Claims which are broad enough to read on statutory subject matter and on nonstatutory subject matter are considered nonstatutory [see In re Lintner, 458 F.2d 1013, 1015, 173 USPQ 560, 562 (CCPA 1972)].

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Odom et al in view of Article entitled "The core of the matter" by Ani Sanyai (Sanyai) in view of Article entitled "Amortizing Intangible Assets" by Farineau et al (Farineau et al) in further view of prior art reference entitled "The Bank Valuation Handbook" to Johnson (Johnson).

Odom discloses a method using a computer system for analyzing a financial asset through which there is obtained a right to sell the asset to a third party at a predetermined price (col 5, lines 10-25). The estimated market value or range is calculated (), and a minimum potential bid price or range is generated and incorporated into the asset as a financial instrument that a third party will pay during a

predetermined term (col 8, lines 3-16). A right to modify is disclosed (col 7, lines 15-60) which broadly includes a right to “substitute”.

Odom does not disclose:

analyzing external market data and internal market data pertaining to the financial institution and inputting at least some of the external market data and internal market data to the computer system; and,

financial institution obtains a right to sell the deposit liabilities to a third party at a predetermined price

quantifying the value of deposit liabilities.

Farineau et al discloses financial institution obtains a right to sell the deposit liabilities to a third party at a predetermined price (see page 34, section entitled “core deposit base”).

Sanyai discloses analyzing external market data and internal market data pertaining to the financial institution and inputting at least some of the external market data and internal market data to the computer system (see page 26, first column).

Johnson discloses quantifying the value of deposit liabilities (see section entitled “financial statement disclosure”).

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It would have been obvious to one with ordinary skill in the art to include a financial institution obtains a right to sell the deposit liabilities to a third party at a predetermined price because Farineau et al teaches such as the result of bank accusations requiring analysis of core deposits (see page 34, section entitled "core deposit base").

It would have been obvious to one with ordinary skill in the art to include analyzing external market data and internal market data pertaining to the financial institution and inputting at least some of the external market data and internal market data to the computer system because Sanyai teaches that core deposits are an important valuation which may be valued by analyzing external market data and internal market data pertaining to the financial institution and inputting at least some of the external market data and internal market data to the computer system (see page 26, first column).

It would have been obvious to one with ordinary skill in the art to include quantifying the value of deposit liabilities because Johnson teaches that deposit liabilities are considered part of core deposit intangibles (see section entitled "financial statement disclosure").

Terminal Disclaimer

9. The terminal disclaimer filed on 5-6-03 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent 6,363,360 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Conclusion


10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alain L. Bashore whose telephone number is 703-308-1884. The examiner can normally be reached on about 7:00 am to 4:30 pm (Monday thru Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Alain L. Bashore
Primary Examiner
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